

Application No.: 10/816,568

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Docket No.: 532792000700

REMARKS

Claims 1-20 are pending in the present application. By this amendment, claims 1, 10, 11, and 12 have been amended, and claims 21-32 have been added. Accordingly, claims 1-32 are currently under consideration. Applicant respectfully submits that these claims are allowable.

Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Amendments to the Specification

The specification has been amended to correct for certain informalities. No new matter has been added.

Objections to Oath or Declaration

The oath or declaration stands objected to as being defective because it does not identify the citizenship of each inventor. Applicant respectfully points out that the citizenship of each inventor is identified in the signature block. Applicant respectfully requests that the above-cited objection be withdrawn.

Objections to Drawings

The drawings stand objected to because of certain informalities related to reference numbers. Paragraph 85 has been amended to revise the description of Figure 3, and Paragraph 98 has been amended to revise the description of Figure 5. Applicant respectfully requests that the above-cited objection be withdrawn.

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Claim Objections

Claims 11 stands objected to because of a lack of proper antecedent basis for "biological signals." Claim 11 has been amended to remove the reference to "biological." Applicant respectfully requests that the above-cited objection be withdrawn.

Claim Rejections Under 35 USC § 102 and 35 USC § 103

Claims 1 and 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kadambe (U.S. Patent Application No. 2003/0061035). Claims 2-9 and 11-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kadambe in view of Lee et al. (U.S. Patent No. 6,424,960).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131) "To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (*In re Royka*, 490 F.2d 981) (MPEP § 2143.03)

Applicant respectfully submits that the claims, as amended, are allowable over the cited references and all references of record. Independent claims 1 and 12 have been amended to include limitations related to "*complex sources*." These limitations are not disclosed or suggested by the cited references. Therefore claims 1 and 12 are allowable. Because they depend directly or indirectly from claim 1, claims 2-11, and 21-25 are likewise allowable. Because they depend directly or indirectly from claim 12, claims 13-20 and 26-31 are likewise allowable.

According to the Office Action, "Regarding claims 4-6 and 11, the processing set forth in these claims is standard and expected signal processing for extracting usable MRI and EEG data. ... Regarding claims 12-20, Kadambe and Lee et al. disclose the signal processing is performed by a system including a computer and memory, which carry out the disclosed memory and steps." With respect to these rejections, Applicant respectfully submits that the Examiner has improperly relied upon inherency in support of the rejection. Reliance on inherency when the reference is silent about the asserted inherent characteristic requires a rationale or evidence showing inherency. MPEP §

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2112. The rationale or evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities." In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted); MPEP §§ 2112, 2131.01.

Applicant respectfully requests that the above-cited rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(a) be withdrawn.

New Independent Claims

New independent claim 32 has been added to the application. Claim 32 is allowable for the reasons presented above in support of claim 1.

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CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **532792000700**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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